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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/288,475	04/08/1999	JOEL ZDEPSKI	OPTVP002	7545

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/23/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/288,475

Applicant(s)

ZDEPSKI, JOEL

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. This Action is in response to the Amendment and Reply received on 23 September 2003.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 September 2003 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 20 recites the limitation "said received message, said message, said predetermined message type, said sender, said one or more options". There is insufficient antecedent basis for this limitation in the claim.

- b. Claim 22, recites the limitation "the option". There is insufficient antecedent basis for this limitation in the claim.

- c. Claim 31, recites the limitation "said message, said sender, and said indicators. There is insufficient antecedent basis for this limitation in the claim

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 20-24, 29, 31-34 and 37-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Noguchi et al. (Noguchi), U.S. Patent No. 6,163,345 in view of Cleron et al. (Cleron), U.S. Patent No. 6,223,213.

7. Regarding **claim 20**, Noguchi discloses the invention substantially as claimed. Noguchi discloses *a method for responding to an e-mail message comprising: receiving an e-mail message created by an original sender and addressed to a user* [see Noguchi, Col. 8, lines 63-67 and Col. 9, lines 1-34]; *determining whether said received message includes an indication that said message corresponds to a predetermined e-mail message type* [see Noguchi, Figure 12D, Col. 9, lines 1-34]. However, Noguchi does not explicitly disclose said predetermined message type being created by said sender to include a main message and one or more user selectable option indicators, each of said indicators including a first text which describes a corresponding option; and a second text which further describes the corresponding option, said second text being displayed in response to a user selecting the corresponding option; in response to determining said message does correspond to said predetermined type, formatting and presenting said message according to a first format, wherein said first format includes the display of the main message and a first text corresponding to each of said one or more options presenting a

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second text corresponding to a first option of said one or more options in response to detecting said first option is selected; and determining whether a reply message identifying the first selected option is to be transmitted to the sender.

8. In the same field of endeavor, Cleron discloses (e.g., a browser based email system connected to a mail server). Cleron discloses said predetermined message type being created by said sender to include a main message and one or more user selectable option indicators, each of said indicators including a first text which describes a corresponding option; and a second text which further describes the corresponding option, said second text being displayed in response to a user selecting the corresponding option; in response to determining said message does correspond to said predetermined type: formatting and presenting said message according to a first format, wherein said first format includes the display of the main message and a first text corresponding to each of said one or more options presenting a second text corresponding to a first option of said one or more options in response to detecting said first option is selected; and determining whether a reply message identifying the first selected option is to be transmitted to the sender [see Cleron, Figures 9 and 10, Col. 3, lines 25-67, Col. 5, lines 15-67, Col. 6, lines 1-67 and Col. 7, lines 1-56].

9. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Cleron's teachings of a browser based email system connected to a host server with the teachings of Noguchi, for the purpose of improving browser-based email systems for capturing audio and video clips within an email message utilizing a browser-based set-tip box (STB), [see Cleron, Col. 1, lines 10-67 and Col. 2,

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lines 52-56]. Therefore, it is for this reason, that Noguchi would have been motivated to further customize the messaging system of set top boxes. By this rationale **claim 20** is rejected.

10. Regarding **claim 21**, Noguchi-Cleron further discloses *wherein said predetermined type is an one-touch email type* [see Noguchi, Col. 9, lines 17-34]. By this rationale **claim 21** is rejected.

11. Regarding **claim 22**, Noguchi-Cleron further discloses wherein said second text describes a corresponding option in greater detail than a first text which corresponds to the option [inherent feature]. By this rationale **claim 22** is rejected.

12. Regarding **claim 23**, Noguchi-Cleron further discloses *wherein the electronic message is received via an interactive television system* [see Noguchi, Col. 1, lines 63-67, Col. 2, lines 1-45]. By this rationale **claim 23** is rejected.

13. Regarding **claim 24**, Noguchi-Cleron further discloses *wherein the at least one option is selected by using a television remote control device* [see Noguchi, Figure 1, item 5]. By this rationale **claim 24** is rejected.

14. Regarding **claim 29**, Noguchi-Cleron further discloses *wherein the received message corresponds to an advertisement for a product or service, and wherein said reply message indicates an interest in the product or service by the user* [see Cleron, Col. 2, lines 52-53]. By this rationale **claim 29** is rejected.

15. Regarding **claim 31**, Noguchi-Cleron further discloses *a method for sending an e-mail message* [see rejection of claim 20, supra] *comprising: creating an e-mail message, said message including: an indication said e-mail message corresponds to a predetermined e-mail message type of a plurality of e-mail message types* [see rejection of claim 20, supra]; *a main message; at*

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least one selectable option; information related to the option, wherein the information is to be presented after the option has been presented and selected; and transmitting the e-mail message [see rejection of claim 20, supra]. By this rationale **claim 31** is rejected.

16. Regarding **claim 32**, Noguchi-Cleron further discloses *wherein the predetermined type is an one-touch email type* [see rejection of claim 21, supra]. By this rationale **claim 32** is rejected.

17. Regarding **claim 33**, Noguchi-Cleron further discloses *wherein the electronic message is transmitted via an interactive television system* [see rejection of claim 23, supra]. By this rationale **claim 33** is rejected.

18. Regarding **claim 34**, Noguchi-Cleron further discloses *wherein, the at least one option is to be selected by using a television remote control device* [see Noguchi, Figure 1, item 5]. By this rationale **claim 34** is rejected.

19. Regarding **claim 37**, Noguchi-Cleron further discloses *wherein the main message corresponds to an advertisement for a product or service, and wherein said option is selectable by a user to indicate an interest in said product or service* [see rejection of claim 29, supra]. By this rationale **claim 37** is rejected.

20. **Claim 38**, list all the same elements of **claims 1 and 31**, but in system form rather than method form. Therefore, the supporting rationale of the rejection to **claims 1 and 31** applies equally as well to **claim 38**.

21. **Claim 39**, list all the same elements of **claims 1 and 31**, but in apparatus form rather than method form. Therefore, the supporting rationale of the rejection to **claims 1 and 31** applies equally as well to **claim 39**.

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Claim Rejections - 35 USC § 103

22. **Claims 25, 26, 27, 28, 30, 35, 36 and 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Noguchi-Cleron and in further view of well known in the art.

23. Regarding **claim 25**, Noguchi discloses the invention substantially as claimed. However, Noguchi does not explicitly disclose wherein in response to determining said reply message is to be transmitted, the reply message is automatically generated and sent responsive to a single indication received from a viewer ((The inclusion of automatically generated a reply message and sent responsive to a single indication received from a viewer would have been obvious to one of ordinary skill in the networking art at the time the invention was made in view of the notoriously widely known and widely implementation of these features in the networking art. The Examiner takes **Official Notice** (MPEP 2144.03) that “wherein in response to determining said reply message is to be transmitted, the reply message is automatically generated and sent responsive to a single indication received from a viewer in the email environment is well known in the networking art at the time the invention was made as exemplified by the notoriously well known application Microsoft Office as well as other well known email application relevant to this application. The Applicant is entitled to traverse the official notice according to MPEP 2144.03. However, MPEP 2144.03 further states, “See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice).” Specifically, *In re Boon*, 169 USPQ 231, 234 states “as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did

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not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further 37 CFR 1.671©(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given little weight). By this rationale **claim 25** is rejected.

24. Regarding **claim 26**, Noguchi-Cleron and well known discloses *wherein the reply message is sent to the original sender of the received electronic message* [see rejection of claim 25, supra]. By this rationale **claim 26** is rejected.

25. Regarding **claim 27**, Noguchi-Cleron and well known does not explicitly disclose further *comprising determining whether a second option has been selected if it is determined that the reply message identifying the selected option is not to be transmitted* (However, such limitations are a matter of design choice (see MPEP 716.02(f)) and would have been obvious to the system of Noguchi-Cleron. Since, Cleron does specifically teach the option of sending a reply to the email. The limitations of claim 27 do not define a patentable distinct invention over that defined in the combined teachings of Noguchi-Cleron-well known in the art. By this rationale **claim 27** is rejected.

26. Regarding **claim 28**, Noguchi-Cleron and well known discloses *wherein in response to detecting said first option is selected, the method further comprises displaying a message to the user indicative of a single input from the user which will generate and send a reply message to the sender, said reply message including an identification of the first option and the* [see Noguchi, Figure 1, item 5]. By this rationale **claim 28** is rejected.

27. Regarding **claim 30**, Noguchi-Cleron and well known discloses *wherein the selected option is identified in a header of the reply message* (The Examiner takes Official Notice (MPEP

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2144.03) that this feature is extremely well known in the art for an email message reply to include a header). By this rationale **claim 30** is rejected.

28. Regarding **claim 35**, Noguchi-Cleron and well known discloses *wherein the at least one option is to be identified in an automatically generated reply message if the at least one option is selected* [see rejection of claim 25, supra]. By this rationale **claim 35** is rejected.

29. Regarding **claim 36**, Noguchi-Cleron and well known discloses *wherein the selected option is identified in a header of the reply message if the selected option is to be transmitted* [see rejection of claim 30, supra]. By this rationale **claim 36** is rejected.

30. Regarding **claim 40**, *wherein the computer readable medium is selected from the group consisting of CD-ROM (The Examiner takes Official Notice (MPEP 2144.03), floppy disk, tape, flash memory, system memory (see Noguchi, Col. 4, lines 49-50], hard drive, and data signal embodied in a carrier wave* [This feature is inherent within any electromagnetic wave that can be modulated; as in the frequency, amplitude, or phase, in order to transmit speech, music, images, or other signals]. By this rationale **claim 40** is rejected.

Response to Arguments

31. Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection,

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fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Noguchi-Cleron and other prior arts of records disclose a predetermined message type, and different options as well as other claimed features of Applicant's invention. It only claims, selecting different options within an email message, which allows the sender the chance to select an option. And within those options, there are specific templates that correspond to each of the options that are selected. In response, the receiver is given the opportunity to also select an option that further describes the specific option selected. It is suggested that Applicant further clarify in more details the predetermined message type, options, first format. It is also, the position of the Examiner, that having selectable options within an email message is extremely well known in the art. Thus, it is clear that Applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claim invention.

32. Applicant employs broad language, which includes the use of word, and phrases (i.e., predetermined message type), which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

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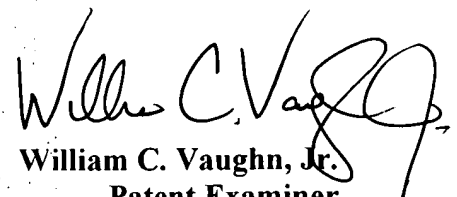
33. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

Conclusion

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.


William C. Vaughn, Jr.
Patent Examiner
Art Unit 2143
08 December 2003